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**SPECIAL PROGRAMS OFFICE
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In re Application of
Zhang, Thwin, Wu and Cho
Application No. 08/975,519
Filed: November 20, 1997
For: Method for the Production and
Purification of Adenoviral Vectors

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: DECISION REFUSING STATUS
: UNDER 37 CFR 1.47(a)
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This is in response to the petition under 37 CFR 1.47(b), filed
May 22, 1998 which has been treated as a petition under 37 CFR
1.47(a).¹

The petition is dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date of
this decision to reply, correcting the below-noted deficiencies.
Any reply should be entitled "Request for Reconsideration of
Petition Under 37 CFR 1.47(a)," and should only address the
deficiencies noted below, except that the reply may include an
oath or declaration executed by the non-signing inventor.
Failure to respond will result in abandonment of the application.
Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on November 20, 1997
without an executed oath or declaration and naming Zhang, Thwin,
Wu, and Cho as a joint inventors.

Accordingly, on February 23, 1998, a "Notice to File Missing
Parts of Application" was mailed, requiring an executed oath or
declaration and a filing fee, and a surcharge for their late
filing.

In response, on May 22, 1998, the filing fee, the instant
petition and a Declaration signed by joint inventors Shuyuan,

¹A petition under 37 CFR 1.47(b) is inappropriate in this
instance since all but one of the inventors has signed the
declaration. A petition under 37 CFR 1.47(b) is only appropriate
where none of the inventors will sign, accordingly the petition
will be treated as a petition under 37 CFR 1.47(a).

Capucine, and Zheng were filed, among other things. The petition was accompanied by a declaration of Dr. Kevin Casement stating that he contacted Dr. Cho by phone and asked that he sign the oath and declaration papers and that he forwarded to the papers to Dr. Cho. Dr. Casement also states that in a follow-up call Dr. Cho refused to sign the papers.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks items (1) and (2) set forth above.

As to item (1), applicant appears to demonstrate that Dr. Cho was only presented with the declaration. Unless Dr. Cho was presented with a copy of the application papers (specification, claims and drawings), Dr. Cho could not attest that he has "reviewed and understands the application papers" and therefore could not sign the declaration which he was given. Accordingly, Rule 47 applicant failed to show or provide proof that the inventor has refused to sign the declaration. Did the inventor receive the application papers? See Manual of Patent Examining Procedure, Section 409.03(d). Petitioner should show that a copy of the application papers was presented to the inventor, but that he did not respond to the request that he sign the oath/declaration in order to show that the inventor has refused to join in the application. The proof of the pertinent events should be made by a statement of someone with first hand knowledge of the events.

As to item (2), an oath or declaration in compliance with 37 CFR 1.63 and 1.64 has not been presented because the inventors have not executed the declaration on behalf of Dr. Cho. Note that the residence, citizenship and post office address of Dr. Cho have been omitted. An oath or declaration in compliance with 37 CFR 1.63 and 1.64 signed by the inventors on behalf Dr. Cho is REQUIRED. See MPEP 409.03(a).

It is noted that the power of attorney by assignee is defective because it does not include a copy of the assignment document (the copy submitted therewith was for submission to assignment division). Moreover, since Dr. Cho has not signed the assignment document, there is no assignee of the entire interest and Introgen Therapeutics should not claim to be. Introgen may, however, take action as assignee of the Rule 1.47 applicant.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Special Program Law Office

By hand: One Crystal Park, Suite 520
2011 Crystal Drive
Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at (703) 306-3159.



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for Patent Policy and Projects